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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,412	12/03/2003	Wayne L. Poll	3991019-147513	5592

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EXAMINER
HOUSTON, ELIZABETH

ART UNIT	PAPER NUMBER
3731	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/726,412	POLL, WAYNE L.	
	Examiner	Art Unit	
	Elizabeth Houston	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/3/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 1, 12 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how the inner *core* can longitudinally extend through the *core* and move relative to the *core*. In other words, how can the inner core extend through itself or move relative to itself?

Claim Objections

2. Claim 5 is objected to because of the following informalities: There is lack of antecedent basis for the limitation "the outer core" in line 3. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1, 2, 4-6, 8, 9, 11-13, 15-17, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Dretler (USPN 4,927,426).**

5. Dretler discloses a surgical instrument comprising an outer sheath (21) having a basket (20) sized for entrapping stones and located near the distal end of the outer

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sheath; an inner core (24 and 30) longitudinally extending through the sheath and longitudinally movable relative to the sheath; and the distal end of the inner core is adapted to engage and fragment the stones (Col 3, lines 14-17 and lines 28-31). Movement of the inner core relative to the sheath transforms the basket from an expanded condition (Fig. 5) to a collapsed condition (Fig. 3). An abutment of the inner core (distal tip) engages an abutment of the outer sheath (distal most portion of (20) as seen Fig. 5) to deform the basket from the expanded (Fig. 5) to the collapsed (Fig. 3) condition upon longitudinal movement of the inner core relative to the outer sheath in a direction toward the distal end of the outer sheath. The outer sheath is provided with an opening so that the inner core can extend through the opening and past the distal end of the outer core. It is inherent that there is an energy source connected to the inner core to provide energy to the optical fiber (30) for fragmenting stones. The energy source is a laser or vibrating device (Col 3, line 28 states that other disintegration methods include ultrasound which would use vibration).

6. Claims 1-6, 8, 10, 12-14, 16, 17, 19 and 20 are rejected under 35

U.S.C. 102(b) as being anticipated by Clement (USPN 5,197,968).

7. Regarding claims 1-4, 8 and 10, Clement discloses a surgical instrument comprising an outer sheath (17) having a distal end at location (60) and having a basket (50) sized for entrapping stones and located near the distal end of the outer sheath; an inner core (30) longitudinally extending through the sheath and longitudinally movable relative to the sheath; and the distal end of the inner core is capable of engaging and

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fragmenting stones (when enough force is applied). Movement of the inner core relative to the sheath (in other words when the sheath is held still and the inner core is extended most distally (as in Fig. 5)) will transform the basket from an expanded condition (Fig. 3) to a collapsed condition (Fig. 5). An abutment of the inner core (distal tip, 31) engages an abutment of the outer sheath (64) to deform the basket from the expanded (Fig. 5) to the collapsed (Fig. 3) condition upon longitudinal movement of the inner core relative to the outer sheath in a direction toward the distal end of the outer sheath. The basket is preformed in the expanded condition to resiliently return to the expanded condition from the collapsed condition upon removal of force applied by the inner core (Col 4, line 41-45). It is inherent that there is some kind of energy source moving the inner core to contact the tissue/stones. The energy source can be considered a drilling device in that it would be necessary to provide repeated blows to the stone in order to fragment it with the distal tip of the inner core.

8. Regarding claims 1, 5, 6, 12-14, 16, 17, 19 and 20, the distal tip of the sheath is at location (54) where the sheath overlaps with the proximal portion of the basket. In this case the inner core can extend through the opening provided by the sheath and past the distal end of the sheath. The inner core is movable from a retracted position within the basket (as in Fig. 2) to an extended position past the distal end of the outer sheath (as in Fig. 3, 5 or 6).

9. **Claims 1, 5-8, 11, 12 and 16-19 rejected under 35 U.S.C. 102(b) as being anticipated by Bates (USPN 6,099,534).**

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10. Bates discloses a surgical instrument comprising an outer sheath (18) having a basket (10) sized for entrapping stones and located near the distal end of the outer sheath; an inner core (29) longitudinally extending through the sheath and longitudinally movable relative to the sheath; and the distal end of the inner core is adapted to engage and fragment the stones (Col 7, line 24). The outer sheath is provided with an opening so that the inner core can extend through the opening and past the distal end of the outer core. The inner core is moveable from a retracted position within the basket (when the basket is contracted in the sheath) to an extended position past the distal end of the outer sheath (as in Fig 5A). The distal end of the inner core is provided with a blunt nose for fragmenting the stones. The energy source for fragmenting is a laser (Col 7, line 18).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Houston whose telephone number is 571-272-7134. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

eh
3/28/07

ANHTUAN T. NGUYEN
SUPERVISORY PATENT EXAMINER

3/28/07